REMARKS

Claims 1-5 are pending. Page 5, line 7, of the Specification and claim 1 have been amended to correct a typographical error. The amendment would not create new matter because in the original application as filed, page 38, line 18, of the Specification discloses that the test piece was immersed in hot water for **5 seconds**. Claim 3 has been amended to correct a grammatical error. Applicants submit that the amendments to claims 1 and 3 would not narrow the scope of the amended recitations.

Claim Rejections – 35 USC § 102(b)

Claims 1-5 were rejected under 35 USC § 102(b), as allegedly being anticipated by EP 1055506; JP 2000169602; JP 2001169601; JP 2000135737; JP 2002046176; JP 2002046173; JP 2001205703; JP 2000167928; and JP 2002046178. Applicants respectfully traverse the rejections.

The Examiner contends that the cited prior art references disclose a heat-shrinkable polyester film having heat-shrinkage percent characteristics as claimed. Applicants disagree because none of the references cited disclose a heat-shrinkable polyester film that satisfies element (C) as recited in the instant claims. Specifically, element (C) as recited requires the difference in heat shrinkage percentages between film that is 10% pre-shrunk and film that is not pre-shrunk to be between 10 - 20%. Such a difference is not taught or suggested by any of the references cited.

Further, Applicants point out that it is not inherent for a film that satisfy elements (A) and (B) to also satisfy element (C) as recited in the claims. For example, Examples 4, 9, and 10, while satisfying (A) (10-50% heat shrinkage under 70 °C) and (B) (70% or more heat shrinkage under 85 °C), clearly do not satisfy element (C) (Δ between 10 - 20%). See Table 4. Also, as stated in the specification, "when common heat-shrinkable polyester films are additionally heat shrunk after they are once heat shrunk to an extent of 10%, ... the difference in heat shrinkage percentage Δ above becomes greater than the above range." See page 9, line 20 to page 10, line 4, of the Specification. Therefore, it is not inherent for the films disclosed in the references to possess the characteristics as recited in the claims.

For at least the reasons stated above, withdrawal of the rejections is respectfully requested.

Claim Rejections – 35 USC § 102(e)

Claims 1-5 were rejected under 35 USC § 102(e), as allegedly being anticipated by Itoh et al. (US 5,451,445). However, US 5,451,445 is a patent to Wang, which is not relevant to polyester film. Applicants assume that this rejection was made over Ito et al. (US 6,451,445, the '445 patent) cited in the Information Disclosure Statement filed May 16, 2005. If this assumption is not correct, applicants request that the Examiner clarify the prior art reference relied upon. Applicants respectfully traverse the rejections.

Similar to the references cited above, the '445 patent does not disclose a heat-shrinkable polyester film that satisfies element (C) as recited in the claims. For the same reasons as stated above, it is not inherent for the film disclosed in the '445 patent to possess the characteristics as recited in the claims. Therefore, withdrawal of the rejections is respectfully requested.

Claim Rejections – 35 USC § 101

Claims 1, 3, and 5 are rejected under 35 USC § 101, as allegedly claiming the same invention as that of claims 1, 3, and 4 of US Patent Nos. 5,548,437 and 6,663,928 (the '928 patent) and that of claims 1, 2, and 7 of US Patent No. 6,548,595 (the '595 patent). However, US Patent No. 5,548,437 does not contain any claims directed to polyester films. Withdrawal of the rejection over US 5,548,437 is requested. Applicants respectfully traverse the double patenting rejections over the '928 patent and the '595 patent because the allegedly conflicting claims are not coextensive in scope.

Specifically, as discussed generally above, element (C) as recited in the instant claims is not one of the limitations in the claims of the '928 and '595 patents. Additionally, the heat shrinkage percentages are different among the claims of the present application and those of the references cited. For example, claim 1 of the present application requires a heat shrinkage percentage of between **10 to 50%** after immersing the test piece in 70 °C hot water for 5 seconds and subsequently in 25 °C water for 10 seconds; however, claim 1 of the '928 and claim 1 of the '595 patents require a heat

shrinkability of **5 – 60%** after treatment in hot water at 70 °C for 5 seconds. Because there exist embodiments of the invention that fall within the scope of one claim but not the other, statutory double patenting does not exist. See M.P.E.P 804 II (A).

For at least the reasons stated above, withdrawal of the rejections is respectfully requested.

CONCLUSION

The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of the subject application.

The Commissioner is authorized to charge any fees for extension(s) of time or additional fees required in connection with the filing of this paper, or to credit any overpayment, to Kenyon & Kenyon's Deposit Account No. 11-0600.

Respectfully submitted,
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